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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/605,965	06/28/2000	Yukio Tada	39303-20145.00	5999

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EXAMINER

LAO, LUN S

ART UNIT PAPER NUMBER

2644

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/605,965

**Applicant(s)**

TADA, YUKIO

**Examiner**

Lun-See Lao

**Art Unit**

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-10, 12 and 15-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-4, 7-9 and 26 is/are allowed.
- 6) ☒ Claim(s) 5, 6, 10, 12 and 15-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Introduction***

1. This action is in response to the amendment filed on 10-13-2005. Claims 5-6, 15 and 26 have been amended and claims 1, 11 and 13-14 have been canceled. Claims 2-10, 12 and 15-26 are pending.

### ***Continued Prosecution Application***

2. The request filed on 10/13/2005 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/605,965 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 6, 10, 12, 15-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over author admitted prior art (page 1, line 10 - page 3, line 14, fig. 4,

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hereafter APA) in view of Tsurumi et al (US Pat. 5,890,910) and Funahashi et al (U S PAT. 5,619,425).

Regarding claim 15, APA teaches a recording apparatus comprising:

a portable player (portable player) carrying a storage medium (EEP-ROM) that stores sound data (store music data) (page 1, lines 10-19);

a recording device (PC 4) that records the sound data to the storage medium carried by the player (download to EEP-ROM, page 2, lines 5-9).

APA does not teach the sound data having type data capable of being designated by a user of the player, reception device that receives the type data transmitted from a source wherein the reception device receives new sound data including the type data designated by the user; recording is performed when the type data transmitted from the source matches the type data designated by the user, and does not match any of the type data of the sound data previously recorded in the recording device.

Tsurumi teaches sound data (release file) has type data (release number) (col. 5, lines 19-45). Tsurumi also teaches a reception device (communication control unit 12) that receives type data (release number) transmitted from a source (host) (col. 5, lines 1-52) and performs recording when the type data transmitted from the source matches the type data (release file having next or succeeding release number) and the sound data has not been recorded (not yet transmitted) (col. 6, lines 35-59).

Tsurumi further teaches that new sound data includes type data (release number) and does not match any of the type data of the sound data previously recorded

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in the recording device in that the latest release number included in a downloaded release file is the release number of the release file which is lastly downloaded from the host apparatus. In the following download, only the release file having the next release number is downloaded. (col. 5, lines 1-18; col. 7, line 56 – col. 8, line 6). In other words, the next release number of Tsurumi represents the type data (release number) that does not match any of the type data of the previously downloaded music data sets.

Therefore, it would have been obvious to include type data, reception device into the system of APA, and to record when the type data transmitted from the source matches the type data and the sound data has not been recorded. One of ordinary skill in the art would have been motivated to combine the teachings of APA and Tsurumi because this would have sped up the downloading process by storing/saving only necessary/timely information (col. 5, lines 7-18), which is desirable in APA (APA, page 3, lines 4-7).

APA as modified by Tsurumi does not teach the type data is designated by a user of the player.

Funahashi teaches sound data (sound information) has type data (genre) which is designated by a user at a terminal (user selects particular genre, data selection means, col. 2, lines 8-28, col. 4, lines 28-39 and 52-66). Given the teaching of Funahashi, it would have been obvious to allow the user of the player / terminal to designate the type data in APA as modified by Tsurumi. One of ordinary skill in the art would have been motivated to combine the teachings of APA as modified and Funahashi because this would have allow a user to contract/designate data by genre so

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that a user can access at a terminal/player only information tailored to the user's taste (col. 1, line 63 – col. 2, line 7).

Further, APA teaches the player is placed on a table (table) when music data is downloaded to the player (page 1, line 27 – page 2, line 9). APA does not teach type data of music data stored in the storage medium provided in the player is read as known type data when the player is placed on the table. Tsurumi teaches type data of music data stored in the storage medium provided in the player is read as known type data (release number of the release file lastly downloaded, col. 5, lines 1-18). Therefore, it would have been obvious to read type data of music data stored in the storage medium provided in the player as known type data in APA. Note discussion above for a motivation to combine. When the teachings are combined, it would have been obvious that such reading is performed when the player is placed on the table because this would have been the configuration that allows data I/O between the computer and the player.

Regarding claim 16, APA as modified teaches the type data is at least one of genre data, singer data and number data (Tsurumi, release number, col. 5, lines 7-18) (Funahashi, genre of sound information, col. 4, lines 28-39, 52-66).

Regarding claim 17, APA teaches music data (music data, page 1, lines 11-19).

Regarding claim 18, APA as modified teaches the center station (host 1) transmits the new music data sets to the download device (terminal 3) (Tsurumi, fig. 1).

Regarding claim 19, APA teaches the player is an MP3 player (MP3 player, page 1, lines 11-19).

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Regarding claim 20, APA as modified teaches the type data transmitted from the source is stored as new type data (Tsurumi, update information, write newly released files to storage area, col. 6, lines 52-59) and is compared with the type data (Tsurumi, col. 7, line 49 – col. 8, line 6; col. 6, lines 52-59) (Funahashi, genre of sound information, col. 4, lines 28-39, 52-66) designated by the user (user selects particular genre, data selection means, col. 2, lines 8-28, col. 4, lines 28-39 and 52-66).

Regarding claim 21, APA as modified teaches (Tsurumi) teaches the type data transmitted from the source is stored as known type data (latest release number, col. 7, lines 25-26; col. 7, line 49 – col. 8, line 6).

Regarding claim 22, APA as modified teaches (Tsurumi) the sound data is recorded when the new type data (next release number) is identical to the type data (release file having next release number and not yet transmitted) and the new data is different from the known type data (latest release number at terminal) (col. 6, lines 1-59). Note discussion of claim 15 with respect to Funahashi for type data being designated by the user.

Regarding claim 23, APA teaches an MPEG encoder and the sound data is encoded by the MPEG encoder (MPEG encoder, page 2, lines 5-10, 20-27).

Regarding claim 24, APA teaches the recording device includes a hard disk drive (HDD 9).

Regarding claim 25, APA teaches the sound data transmitted from the source is recorded in the hard disk drive and transferred to the storage medium (store in HDD and then download to ROM of player, page 2, lines 31-35).

Regarding claim 5, APA as modified by Tsurumi and Funahishi teaches a download control method for a player (APA, portable player; Tsurumi and Funahishi, terminal), comprising the steps of

reading in (by the terminal), as known type data, the type data of the music data sets previously downloaded and stored in the storage medium the player (Tsurumi, release number of the release file lastly downloaded, col. 5, lines 1-18), and APA teaches placing a player on a table (APA, table, page 1, line 27 – page 2, line 9);

reading in (by the terminal), as desired type data (Tsurumi, release number), the type data (Tsurumi, col. 5, lines 19-45), and Funahishi teaches type data being designated and input by a user of the player (Funahashi, user selects/contracts a particular genre at a terminal, col. 2, lines 8-28, col. 4, lines 28-39 and 52-66);

reading in, as new type data, the type data of music data transmitted from a center station and received (Tsurumi, downloaded release file, currently downloaded, col. 8, lines 1-6);

determining whether or not the new type data is equal to desired and different from the known / previously downloaded type data (Tsurumi, col. 6, lines 35-59; col. 7, line 52 – col. 8, line 6; fig. 4);

storing (store) the music data transmitted from the center station in a data memory device when the new type data is equal to desired and different from all known type data (Tsurumi, col. 6, lines 1-59; col. 7, line 52 – col. 8, line 6);



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downloading the music data stored in the data memory to the storage medium of the portable player (APA, PC downloads music data stored in HDD to EEPROM of player, page 2, lines 5-9); and

rewriting the new type data as known type data (Tsurumi, update information, write newly released files to storage area, col. 6, lines 52-59). Note discussion of claim 15 for motivations to combine the teachings of APA, Tsurumi and Fuanhashi.

Regarding claim 6, it is a program product claim of claim 5, and thus note claim 5 for discussion.

Regarding claims 10, 12, APA teaches the player is a portable player (portable player, page 1, line 11).

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over author admitted prior art (page 1, line 10 - page 3, line 14, fig. 4, hereafter APA) in view of Tsurumi et al (US Pat. 5,890,910) and Funahashi et al (U S Pat. 5,619,425) as applied to claim 15 and further in view of Kim et al (U S Pat. 6,083,009).

Regarding claim 18, APA as modified does not teach the reception device is a tuner and the sound data is received through the tuner.

Kim teaches a recording apparatus (fig. 2), wherein a center station is a radio station (204, transmits radio data), and a reception device is a tuner (208a, 208e, 202) through which the music data sets are received (col. 5, lines 9-62).

Therefore, it would have been obvious to include and a tuner into the system of APA as modified. One of ordinary skill in the art would have been motivated to combine

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the teachings of APA as modified with Kim because this would have allowed a user to listen to music in the fields (col. 2, lines 23-44).

***Allowable Subject Matter***

6. Claims 2-4, 7-9 and 26 are allowed.

***Response to Arguments***

7. Applicant's arguments filed 10-13-2005 have been considered but are moot in view of the new ground(s) of rejection.

As to the argued user designation of type data (remarks, pages 10-12), Funahashi et al (U S Pat. 5,619,425) is cited to teach designation of type data by a user of a portable player, as discussed in detailed in the rejection of claim 15.

Regarding the argued when the portable player is placed on a table, it is met by applicant admitted prior art (page 1, line 27 – page 2, line 9), as discussed in detail in the rejection of claim 15. It is noted that claims 5 and 6 do not specify any technical detail of the table except for reciting “the player has been placed on a table”, which does not even distinguish the table from an ordinary piece of furniture.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lee (US PAT 6,278,048) is recited to show other inventions

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related to download system, download control method, and storage medium for portable players.

9. Any response to this action should be mailed to:

Mail Stop \_\_\_\_ (explanation, e.g., Amendment or After-final, etc.)

Commissioner for Patents  
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Facsimile responses should be faxed to:

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Hand-delivered responses should be brought to:


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lao, Lun-See whose telephone number is (571) 272-7501. The examiner can normally be reached on Monday-Friday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chin Vivian, can be reached on (571) 272-7848.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 whose telephone number is (571) 272-2600.

Lao, Lun-See    ㄌㄞ  
Patent Examiner  
US Patent and Trademark Office  
Knox  
571-272-7501  
Date 01-23-2006

  
HUYEN LE  
PRIMARY EXAMINER